

REMARKS

Applicants acknowledge the Office Action mailed on August 17, 2004 and request reconsideration of the present application in view of the foregoing amendments and the following remarks.

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,186,054 to Brayton, et al. In rejecting the claims as obvious, the Examiner asserts:

Brayton, et al. teach a method of producing blast furnace coke by compacting finely divided coal into a compact such that the bulk density is sufficiently increased to be capable of conversion into coke. The compacted coal cake is then carbonized in an oven, which provides coke, which can be used in steel making productions. (Note, Column 2, Lines 15-60). The compacting means can be in an *[sic]* form suitable for compacting the finely divided coal to achieved *[sic]* the desired coal compact. The preferred method of compacting is by using briquetting rolls, but is not limited to this type of compaction. The coal compact is binderless and after compaction the compact is placed into a coking oven wherein the compacted coal is carbonized into coke, which is suitable for used *[sic]* in steel and iron making. Brayton '054 teaches that the coal compact has a specific gravity of at least about 1.1.

See Office Action, p. 2-3. The Examiner acknowledges, however, "Brayton, et al. does not specifically [teach] providing a container such that vertical dimension of the volume of loose coal in the container is smaller than a horizontal dimension of the volume of loose coal." See Office Action, p. 3. Thus, in rejecting the claims under 35 U.S.C. § 103(a), the Examiner asserts:

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a compaction container as claimed where there is a specific suggestion in the art to provide means for compaction which provide a compacted coal having a density which is greater than that of the loose coal. The reason for compacting, i.e., to [produce] a uniform density coal compact, which is then introduced into a coke oven taught by Brayton et al. is the same reason as claimed by the applicant, the means to effect compaction by any means has been discussed and suggested by Brayton et al. thus to provide compaction

container or container for containing the loose coal so that it may be compressed or compacted to provide a compacted coal product having a density which is greater than that of the loose coal renders applicant's invention as a whole obvious to one having ordinary skill in the art at the time the invention was made.

See Office Action, pp. 3-4.

Applicants respectfully traverse this rejection as it applies to claims 1-6 and 13.

The Examiner's position with respect to independent claims 1 and 13 is essentially that because Brayton, et al. discloses that the "compacting means may be in any form suitable for compacting the finely divided coal to achieve the desired results" (Column 3, lines 47-49) that Applicants' specifically claimed container is obvious. Indeed, under the Examiner's analysis, presumably any and all containers are rendered obvious by the sweeping statement in Brayton, et al. Applicants respectfully submit that this is inconsistent with the governing law.

The Patent and Trademark Office "bears the burden of establishing a case of prima facie obviousness." *In Re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993). In *Bell*, the PTO urged the Federal Circuit to affirm an obviousness rejection because one of the references, the Weissman reference, disclosed that its method "can 'easily' be applied to isolate genes for an array of proteins, including peptide hormones. The PTO thus argues that in view of Weissman, a genus is rendered obvious once the amino acid sequence of its translated protein is known." *Id.* at 785. The Federal Circuit did not agree:

We decline to afford that broad a scope to the teachings of Weissman. While "a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests," we cannot say that Weissman "fairly suggests" that its teachings should be combined with those of Rinderknecht, since it nowhere suggests how to apply its teachings to [amino acid sequences in question].

Id. (quoting *In re Burchel*, 592 F.2d 1175, 1170 (C.C.P.A. 1979). The rationale of *Bell* applies equally to the present application. Brayton, et al.'s disclosure that the compaction means "may be in any form suitable for compacting" is akin to Weissman's sweeping

statement that its method could "easily" be adapted to other proteins. In both instances, there is no specific teaching, suggestion or motivation to produce the claimed invention. Indeed, in *Bell*, the Federal Circuit reversed the determination of obviousness even though a second reference disclosing the amino acid sequence in question was cited in combination with Weissman. Applicants note in the present case that the Examiner has not produced any other reference disclosing Applicants' claimed container. Accordingly, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness and claims 1 and 13 are allowable. As claims 2-6 and 8-12 all depend, directly or indirectly, from independent claim 1, they are likewise considered allowable.

With respect to independent claim 7, Applicants again submit that the Examiner has failed to make out a prima facie case of obviousness. Independent claim 7 specifically includes the step of "moving the coke mass from the oven at a substantially constant elevation to the container." Nowhere in the Office Action has the Examiner indicated where this claim limitation is disclosed, taught or suggested in Brayton, et al. Indeed, Applicants respectfully submit that this limitation is not disclosed, taught or suggested by Brayton, et al. Accordingly, it is respectfully submitted that independent claim 7 is likewise allowable.

Applicants have also added new claims 14-18, which are believed to be allowable over the prior art.

An earnest attempt has been made to respond fully and completely to the Office Action of August 17, 2004. It is believed that all claims are in condition for allowance. Accordingly, passage to issuance is respectfully solicited.

If necessary to affect a timely response, please consider this paper a request for an extension of time, and charge any shortages in fees, or apply any overpayment credits, to Baker & Daniels' Deposit Account No. 02-0387 (26041.50057). Please do not include the payment of issue fees.

Appl. No. 10/641,407
Amdt. Dated February 17, 2005
Reply to Office Action of August 17, 2004

Respectfully submitted,

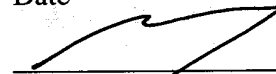


Gerard T. Gallagher
Reg. No. 39,679
BAKER & DANIELS
205 West Jefferson Boulevard, Suite 250
South Bend, IN 46601
Telephone: (574) 234-4149
Fax: (574)239-1900

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February 17, 2005

Date



Gerard T. Gallagher, Reg. No. 39,679